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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,074	05/21/2007	Christian Funke	2400.0380000/VLC/CMB	3350
26111	7590	08/30/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PIHONAK, SARAH	
		ART UNIT	PAPER NUMBER	
		1627		
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		08/30/2011	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/579,074	FUNKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SARAH PIHONAK	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 28 February 2011.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) Claim(s) 6,7 and 20-23 is/are pending in the application.
  - 5a) Of the above claim(s) 6,7,22 and 23 is/are withdrawn from consideration.
- 6) Claim(s) \_\_\_\_\_ is/are allowed.
- 7) Claim(s) 20 and 21 is/are rejected.
- 8) Claim(s) \_\_\_\_\_ is/are objected to.
- 9) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/28/2011</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

This application, filed on 5/21/2007, is a national stage entry of PCT/EP04/12328, filed on 10/30/2004.

**Priority**

This application claims foreign priority to the following applications: 10353278.1, filed on 11/14/2003; and 102004006075.4, filed on 2/7/2004. Certified English language translations have been received for the foreign priority documents, and acknowledgement is made of the claim to the foreign priority date of 11/14/2003.

**Request for Continued Examination**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/19/2010 has been entered.

**Response to Remarks**

2. Claims 6-7, and 20-23 are pending as of the amendments filed on 11/19/2010. Claims 6-7 were previously withdrawn from consideration due to the restriction requirement. Claims 1-5 and 8-19 have been cancelled by the Applicants; all rejections regarding the cancelled claims have been rendered moot.

Newly submitted claims 22-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the elected invention of claim 20 is directed to a combination of a compound of formula II-1-4 and a compound selected from (Ia), (Ik), or (Im), while the inventions of claims 22-23 are directed to methods of preparing a composition and a method of controlling animal pests. The instant application is a national stage entry of an international application, and therefore unity of invention is a requirement for different inventions to be examined together. Unity of invention is not present in the claims, as the composition of claim 20 is found to be *prima facie* over Lahm et. al., WO 2003/015518 publication, in view of Angst et. al., WO 2002/37964.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The indicated allowability of claim 20 in the office action dated 7/19/2010 is withdrawn in further consideration of the claim, and the data provided by the Applicants. The Applicants have cited that the combination of a compound of formula II-1-4 and a compound selected from (Ia) imidacloprid; (Ik) thiacloprid; or (Im) clothianidin, exhibits a synergistic pesticide effect when the ratio of (Ia), (Ik), or (Im) to II-1-4 is from 25:1 to 1:10. However, in consideration of the data

provided in the specification and the declaration submitted by Dr. Andersch on 10/27/2009, the examiner notes that the Applicants have only provided evidence of synergy for one or two points at each end of the ratio range, and not at any other points throughout the range cited. The Applicants have demonstrated synergy for the following combinations: (Ia) and II-1-4 at ratios of 25:1 and 1:10; (Ik) to 11-1-4 at a ratio of 25:1; and (Im) to II-1-4 at ratios of 25:1 and 1:10. The claimed combination is directed to a ratio range of a compound of formula (I) to II-1-4 from 25:1 to 1:10, thus indicating, along with the Applicants' previous arguments, that synergy exists between these combinations at any point throughout the cited range. However, the Applicants have only provided evidence of synergy between (Ik) and II-1-4 at one specific ratio of 25:1, which is not supportive of synergy throughout the cited ratio range. Furthermore, synergy has only been demonstrated for (Ia) and (Ik) to II-1-4 at one point at each end of the ratio range, at 25:1 and 10:1; the Applicants have not shown that synergy exists at a point within this range, such as at a ratio of 1:1. The data provided by the Applicants of a synergistic combination is therefore not commensurate in scope with the claims. Therefore, claim 20 is not found to be free of the prior art, and a rejection is made under 35 USC 103(a) as being unpatentable over Lahm et. al., WO 2003/015518, in view of Angst et. al. , WO 2002/37964, which will be discussed in detail in the office action. The references of Lahm et. al. and Angst et. al. are both of previous record, having been discussed in the previous rejection of claims 1, 8-10, and 12-15.

4. Claims 20 and 21 were examined.

5. Claims 20 and 21 are rejected.

### **Claim Rejections-35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahm et. al., WO 2003/015518 publication, in view of Angst et. al., WO 2002/37964 publication (both of previous record).

The claims are drawn to a composition comprised of a synergistically effective amount of the elected compound of formula (I), clothianidin (Im), and the elected compound of formula (II), 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, in which the ratio of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide ranges from 25:1 to 1:10.

Lahm et. al. teaches a method of controlling pests by application of a compound of formula I, including the compound, 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide (Abstract; p. 1, line 24-p. 3, line 24; p. 42, Example 11), in a mixture with acceptable carriers or diluents (p. 89, lines 1-16). Lahm et. al. also teaches that compounds of formula I, such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, can be combined with at least one additional biologically active compound, to provide broader spectrum pesticide activity (p. 96, lines 23-p. 97, line 33). Particularly, it is taught that preferred compounds for preparing mixtures

with compounds of formula (II) include neonicotinoid compounds such as clothianidin (p. 97, line 37-p. 98, line 2; pp. 139-140, claim 1; pp. 141-142, claims 6, 8, and 9). Lahm et. al. teaches that compounds such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide exhibit activity towards a broad variety of pests (p. 91, line 32-p. 96, line 22).

While Lahm et. al. teaches that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide is mixed preferably with clothianidin for broader spectrum pesticide activity, it is not explicitly taught that the combination is synergistic, or that the ratio range for clothianidin to 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide ranges from 25:1 to 1:10.

Angst et. al. teaches a composition for controlling pests which comprises a compound of formula (A) and additional compounds, including clothianidin (Abstract; p. 1, 3<sup>rd</sup> paragraph; p. 2, right column, 5<sup>th</sup> compound from bottom; pp. 23-24, claim 1). It is taught that the composition comprised of compounds of formula (A) and clothianidin results in a synergistic pesticide (p. 7, 2<sup>nd</sup> paragraph-p. 8, top 2 lines), and that the mixing ratio for compounds of formula (A) to clothianidin ranges from 100:1 to 1:6000, particularly from 1:50 to 50:1 (p. 7, 1<sup>st</sup> paragraph). Angst et. al. teaches that the synergistic combination is effective in protecting a broad variety of crops (p. 11, 2<sup>nd</sup> full paragraph), and that the

combination of compound of formula (A) with clothianidin is less phytotoxic than either agent alone (p. 7, last paragraph-p. 8, top 2 lines).

One of ordinary skill in the art would have been motivated, at the time of the invention, to have prepared a synergistic pesticide composition comprised of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, in a ratio range between 25:1 to 1:10, because Lahm et. al. teaches that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide is preferably combined with neonicotinoids such as clothianidin for increased pesticide action, and Angst et. al. teaches that compositions comprised of clothianidin and other pesticide agents results in a synergistic combination. As the compounds of formula (A) taught by Angst and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide are both pesticides, and are taught to be effective for protecting a variety of crops, it would have been *prima facie* obvious for one of ordinary skill in the art to substitute 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide for compounds of formula (A) in the composition taught by Angst. Particularly, Lahm et. al. teaches that preferred combinations include compounds of formula (II) such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide and clothianidin. Therefore, as it is taught that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl}phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-

5-carboxamide is preferably combined with clothianidin, and Angst et. al. teaches that compositions comprised of clothianidin and other neonicotinoid compounds provide synergistic pesticide action, one of ordinary skill in the art would have expected that combining 3-bromo-N-[4-chloro-2-methyl-6-((methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide with clothianidin would also have provided a potent pesticide effect. Angst et. al. teaches that the ratio ranges of clothianidin to compounds of formula (A) are between 6000:1 to 1:100. As it would have been obvious to substitute 3-bromo-N-[4-chloro-2-methyl-6-((methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide for compounds of formula (A) in this composition, it would have been obvious to prepare a mixture of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-((methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide within the claimed ratio range from 25:1 to 1:10.

### **Information Disclosure Statement**

10. The information disclosure statement (IDS) submitted on 2/28/2011 was filed after the mailing date of the final office action on 7/19/2010. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### **Conclusion**

11. No claim is currently found allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-Thursday 7:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

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